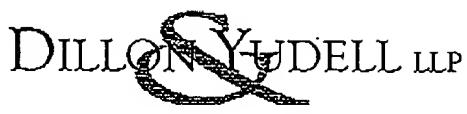


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Richard W. Chester

§ ATTORNEY DOCKET NO.: RP9-98-096

Serial No.: 09/248,160

§ Examiner: Arthur D. Duran

Filed: 02/09/1999

§ Art Unit: 3622

For: S/M FOR INSTALLING
PERSONAL COMPUTER SOFTWARE

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Reply Brief is submitted in answer to the Response to Argument set forth in paragraph 10 of the Examiner's Answer mailed November 29, 2005.

Certificate of Transmission/Mailing

I hereby certify that this correspondence is being facsimile transmitted to the USPTO at 703-872-9306 or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:
Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on the date shown below.

Typed or Printed Name: Jane Graham

Date: January 23, 2006

Signature: Jane Graham

ARGUMENTS

The invention set forth within the Claims under Appeal in the present application is directed to a technique for initially loading software into a personal computer in an unusable form whereby selected software may be later converted into usable form based upon the user's position and requirements, with the non-selected programs not being converted into usable form whereby royalties will be due only on selected software and the software which has been selected may be determined with great accuracy.

In response to Applicant's arguments that "primary references relied upon by the Examiner either teach the loading of software in fully functional evaluation mode onto each computer or a technique whereby none of the software on a computer is usable until the user has agreed to selected terms and conditions." The Examiner notes a belief that *Stringer* discloses several embodiments of his invention in which the software contained therein is "not fully functional or fully usable." Applicant does not dispute this teaching of *Stringer*, however the Applicant notes respectfully, that the claims in the present application are not directed to a technique where by software is loaded in a "not fully functional or not fully usable" form but, as expressly recited within those claims, "in unusable form..." Applicant urges the Board and the Examiner to consider that "unusable" means not capable of being utilized and that software in an "unusable" form is *per se* incapable of being "evaluated," the primary stated function of the *Stringer* system.

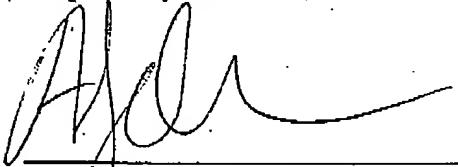
Further, as previously noted, Applicant points out that the *Carroll* reference teaches that all software within the system is unusable until the user has agreed to selected terms and conditions and that thereafter all software, rather than selected programs, is made usable.

In response to Applicant's argument that a combination of these two references would do clear violence to either reference, the Examiner correctly states that the appropriate test for the combination of references is what will be suggested to one having ordinary skill in the art. Applicant respectfully urges the Board to consider that a first reference which expressly teaches software which is loaded in a usable or partially usable evaluation version to permit "a user to evaluate fully functional versions of original materials before purchasing the materials." (See *Stringer*, Column 5, lines 16-19) and a second reference which teaches that all software is disabled until such time as a user has agreed to purchase that software cannot, in good faith,

provide a suggestion for combination to one having ordinary skill in this art. Either the purpose of the system is to permit the software to be utilized and evaluated or the purpose is to prohibit the utilization of the software until it has been purchased. A combination of references which teach these two diverse techniques does not, in the opinion of the Applicant, give rise to a suggestion for combination in the mind of one having ordinary skill in this art.

No fee is believed to be required; however, in the event any fees are required, please charge **Lenovo's Deposit Account No. 50-3533**. No extension of time is believed to be required; however, in the event any extension is required, please consider that extension requested and please charge any associated fee and any additional required fees **Lenovo's Deposit Account No. 50-3533**.

Respectfully submitted,



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Attorney Docket No. AT9-98-096
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